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Page 1 of 1

Docket No.: EIP7.001APC

**CUSTOMER NO. 20995**

Applicant : Ford, Peter  
 App. No. : 09/463,146  
 Filed : April 14, 2000  
 For : ENCRYPTED BROADCAST MESSAGES  
       IN A CELLULAR COMMUNICATIONS  
       SYSTEM  
 Examiner : Lanier, Benjamin E.  
 Group Art Unit : 2132

**CERTIFICATE OF FAX TRANSMISSION**

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 273-8300 on the date shown below:

December 15, 2005

John M. Carson, Reg. No. 34,303

Transmitted herewith for filing and consideration in the above-referenced application are the following items:

- (X) Petition to Withdraw Improper Holding of Abandonment Pursuant to 37 C.F.R. §1.181(a) in (4) pages.
- (X) Exhibits 1-4.
- (X) Total pages in transmission: 29

The Commissioner is hereby authorized to charge any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 11-1410.



John M. Carson  
 Registration No. 34,303  
 Attorney of Record  
 Customer No. 20,995  
 (619) 235-8550

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DEC 15 2005

EIP7.001APC

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ford, Peter  
 Appl. No. : 09/463,146  
 Filed : April 14, 2000  
 For : ENCRYPTED BROADCAST  
       MESSAGES IN A CELLULAR  
       COMMUNICATIONS SYSTEM  
 Examiner : Lanier, Benjamin E.  
 Group Art Unit : 2132

## CERTIFICATE OF FACSIMILE

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 273-8300 on the date shown below:

December 15, 2005

(Date)

John M. Carlson, Reg. No. 34,303

**Petition to Withdraw Improper Holding of Abandonment Pursuant to 37 C.F.R. § 1.181(a)**

**Mail Stop Petition**  
 c/o Technology Center Director  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. § 1.181(a) and MPEP § 711.03(c)(I)(a), Applicant hereby petitions that:

- (1) The Director withdraw the holding of abandonment referenced in the Notice of Abandonment mailed in the above-captioned case on November 1, 2005 (see Exhibit 1), because the requirements for finding the case abandoned as stated in 37 C.F.R. § 1.135(a) have not been met; and
- (2) That the final Office Action originally mailed on March 17, 2005 be reissued upon withdrawal of the improper Notice of Abandonment.

In support of the instant petition, the following items are provided:

1. A printout of the Image File Wrapper Docket for the instant application as recorded in the PAIR system showing that the original final Office Action mailed on March 17, 2005, was returned undelivered on March 30, 2005 (Exhibit 1.)
2. A copy of the final Office Action originally mailed in this case on March 17, 2005 (Exhibit 2).

Appl. No. : 09/463,146  
Filed : April 14, 2000

3. A copy of the August 11, 2005 Letter Restarting Period for Response to the Final Office Action Originally Mailed on March 17, 2005. (Exhibit 3.)
4. A copy of a Notice of Abandonment mailed in connection to the above-captioned application on November 1, 2005. (Exhibit 4.)

Appl. No. : 09/463,146  
Filed : April 14, 2000

#### REMARKS

For the Director's convenience, Applicant attaches a copy of the Private PAIR docket sheet for the above-captioned case (see Exhibit 1). On March 17, 2005, a final Office Action was mailed in this case (see Exhibit 2). The final Office Action was erroneously mailed to a previous correspondence address for the undersigned (620 Newport Center Drive, Newport Beach, CA), instead of being mailed to the correct address that was associated with Customer Number 20,995 at the time of the mailing (2040 Main St., Irvine, CA). On March 30, 2005, the final Office Action was returned undelivered to the Office. Neither Applicant nor his attorneys ever received the March 17, 2005 mailing.

On August 11, 2005, the Office updated the correspondence address to the correct and current mailing address for Applicant's representative, and re-mailed the final Office Action on that date (see Exhibit 3). This re-mailed final Office Action constituted an indication under 37 C.F.R. § 1.135(a) that the response period associated with the March 17, 2005 mailing was no longer in effect. Thus, a new statutory response period should have begun on August 11, 2005, with a final due date of February 11, 2006.

On November 1, 2005, a Notice of Abandonment was mailed in this case for failing to file a reply to the March 17, 2005 final office action (see Exhibit 4). This Notice of Abandonment was improperly issued because the original response due date of September 17, 2005 was no longer in effect due to the re-mailing on August 11, 2005.

Appl. No. : 09/463,146  
Filed : April 14, 2000

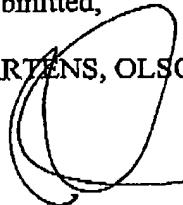
Because the application was not abandoned under the applicable rules, Applicant requests that the improper Notice of Abandonment be withdrawn, and the final Office Action be re-mailed, thereby setting a new statutory deadline for response under 37 C.F.R. §§ 1.134 and 1.135(a).

No fee is believed due for this submission, as it is brought in accordance with the procedure described in M.P.E.P. § 711.03(c)(I), which states that "a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment . . . does not require a fee."

Should a fee be due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Dated: 12/15/05

By: \_\_\_\_\_

John M. Carson  
Registration No. 34,303  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

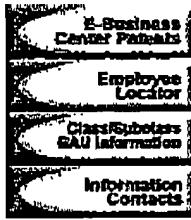
2136536  
113005

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NET

This application is officially maintained in electronic form. To View: Click the desired Document Description link below to view the desired document(s) and click Download.

Mail Room Date	Document Description	Document Category
11/01/2005	<a href="#">Abandonment</a>	PROSECUTION
08/11/2005	<a href="#">Letter Restarting Period for Response (i.e. Letter re: References)</a>	PROSECUTION
03/30/2005	<a href="#">Mail returned to USPTO as undelivered</a>	PROSECUTION
03/17/2005	<a href="#">Index of Claims</a>	PROSECUTION
03/17/2005	<a href="#">Final Rejection</a>	PROSECUTION
02/14/2005	<a href="#">Claims</a>	PROSECUTION
02/14/2005	<a href="#">Amendment - After Non-Final Rejection</a>	PROSECUTION
02/14/2005	<a href="#">Fee Worksheet (PTO-875)</a>	PROSECUTION
02/14/2005	<a href="#">Transmittal to TC</a>	PROSECUTION
02/14/2005	<a href="#">Applicant Arguments or Remarks Made in an Amendment</a>	PROSECUTION
02/14/2005	<a href="#">Authorization for Extension of Time for all replies</a>	PROSECUTION
09/13/2004	<a href="#">List of References cited by applicant and considered by examiner</a>	PRIOR ART
09/13/2004	<a href="#">Non-Final Rejection</a>	PROSECUTION
09/13/2004	<a href="#">Index of Claims</a>	PROSECUTION
09/13/2004	<a href="#">Search Information Including classification, databases and other search related notes</a>	PROSECUTION
09/13/2004	<a href="#">NPL Documents</a>	PRIOR ART
09/13/2004	<a href="#">List of references cited by examiner</a>	PRIOR ART
08/25/2004	<a href="#">Examiner's search strategy and results</a>	PROSECUTION
08/05/2004	<a href="#">NPL Documents</a>	PRIOR ART
08/05/2004	<a href="#">Information Disclosure Statement (IDS) Filed</a>	PROSECUTION
08/05/2004	<a href="#">Foreign Reference</a>	PRIOR ART
08/05/2004	<a href="#">Foreign Reference</a>	PRIOR ART
08/05/2004	<a href="#">Foreign Reference</a>	PRIOR ART

**EXHIBIT 1**

PAGE 6/29 \* RCVD AT 12/15/2005 2:39:33 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-6/25 \* DNI:2738300 \* CSID:16192350176 \* DURATION (mm:ss):05:46 \* 2005

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08/05/2004	Foreign Reference	PRIOR ART
08/05/2004	Foreign Reference	PRIOR ART
08/05/2004	NPL Documents	PRIOR ART
06/14/2004	Amendment - After Non-Final Rejection	PROSECUTION
06/14/2004	Claims	PROSECUTION
06/14/2004	Fee Worksheet (PTO-875)	PROSECUTION
06/14/2004	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
02/11/2004	List of references cited by examiner	PRIOR ART
02/11/2004	List of References cited by applicant and considered by examiner	PRIOR ART
02/11/2004	Non-Final Rejection	PROSECUTION
03/28/2002	Information Disclosure Statement (IDS) Filed	PROSECUTION
03/28/2002	NPL Documents	PRIOR ART
03/28/2002	NPL Documents	PRIOR ART
03/28/2002	Foreign Reference	PRIOR ART
04/14/2000	Oath or Declaration filed	PROSECUTION
04/14/2000	Notice of DO/EO Acceptance Mailed	PROSECUTION
04/14/2000	Miscellaneous Incoming Letter	AS FILED
04/14/2000	Miscellaneous Incoming Letter	AS FILED
04/14/2000	Transmittal to TC	PROSECUTION
03/09/2000	Notice of D.O./EO Missing Requirements Mailed	PROSECUTION
01/18/2000	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
01/18/2000	Claims	PROSECUTION
01/18/2000	Claims Worksheet (PTO-2022)	PROSECUTION
01/18/2000	Fee Worksheet (PTO-875)	PROSECUTION
01/18/2000	Fee Worksheet (PTO-875)	PROSECUTION
01/18/2000	Claims	PROSECUTION
01/18/2000	Specification	PROSECUTION
01/18/2000	Drawings	PROSECUTION
01/18/2000	Transmittal letter	PROSECUTION
01/18/2000	Index of Claims	PROSECUTION
01/18/2000	Search information including classification, databases and other search related notes	PROSECUTION
01/18/2000	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION
01/18/2000	Foreign Priority Papers Filed	PROSECUTION

12/15/05 12:40 FAX 16192350176

KMOB SAN DIEGO

008

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01/18/2000	Documents submitted with 371 Applications	PROSECUTION
01/18/2000	Preliminary Amendment	PROSECUTION

Sorted By : Mail Room Date

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,146	04/14/2000	PETER FORD	RJENK9.001AP	5905

7590 03/17/2005  
**KNOBBE MARTENS OLSON & BEAR**  
 620 NEWPORT CENTER DRIVE  
 SIXTEENTH FLOOR  
 NEWPORT BEACH, CA 92660

EXAMINER	
LAINER, BENJAMINE	
ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**RECEIVED**  
**MAR 30 2005**  
 Technology Center 2100

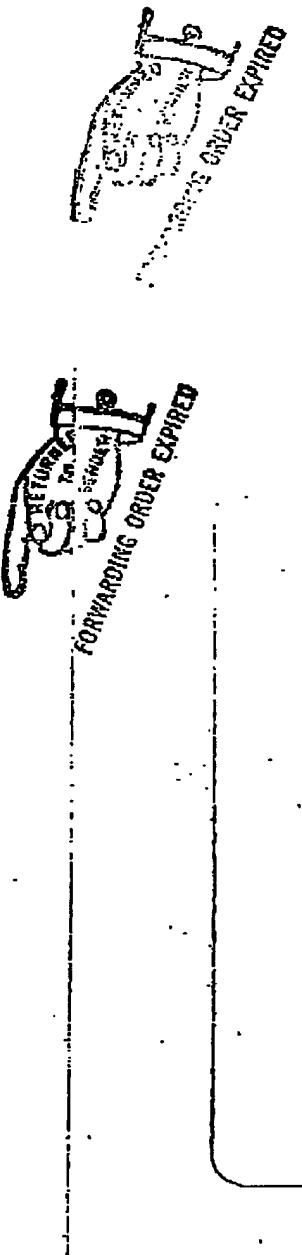
**EXHIBIT 2**



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MAR 30 2005

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/463,146	FORD, PETER
	Examiner	Art Unit
	Benjamin E Lanier	2132

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 11 February 2005.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 19-25 and 27-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19-25 and 27-37 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 January 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1.) Certified copies of the priority documents have been received.  
2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

Application/Control Number: 09/463,146  
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**DETAILED ACTION***Response to Amendment*

1. Applicant's amendment filed 11 February 2005 amends claims 19, 21, 22, 24, 28, 29, 32, 37 and cancels claim 26. Applicant's amendment has been fully considered and is entered.

*Response to Arguments*

2. Applicant's arguments filed 11 February 2005 have been fully considered but they are not persuasive.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. Applicant's arguments that the prior art does not disclose transmitting a transfer protocol identifier indicating that the encrypted broadcast message is of a type for data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module in response to receipt of said transfer protocol identifier is not persuasive because Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). The SMS

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Art Unit: 2132

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messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24), which meets the limitation of data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20), and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Application/Control Number: 09/463,146  
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7. Claims 19, 20, 24-36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290. Referring to claims 19, 20, 24, 25, 27-30, 32-34, 36, and 37, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20), and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

Referring to claim 26, Diachina discloses that the SMS messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33).

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Referring to claims 31 and 35, Diachina discloses that the channel can be GSM (Page 6, line 20).

8. Claims 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290 as applied to claim 19 above, and further in view of Farrugia. Referring to claims 21-23, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). Diachina does not disclose storing the keys on the smart cards in an encrypted form. Farrugia discloses the use of smart card technology with cellular networks where the key used to decrypt encrypted cellular message are stored in an encrypted fashion on the smart card of the subscribers mobile terminal (Page 101). It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the keys of Diachina on the smart cards in order to control access to the keys as taught in Farrugia (Page 102).

*Conclusion*

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

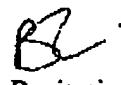
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

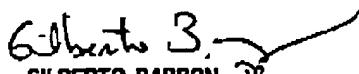
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Benjamin E. Lanier

  
GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,146	04/14/2000	PETER FORD	RJENK9.001AP	5908
20995	7590	08/11/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			LANIER, BENJAMIN E	
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			2322	

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,146	04/14/2000	PETER FORD	R/ENK9.001AP	5908
7590	03/17/2005		EXAMINER	
KNOBBE MARTENS OLSON & BEAR 620 NEWPORT CENTER DRIVE SIXTEENTH FLOOR NEWPORT BEACH, CA 92660			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 03/17/2005

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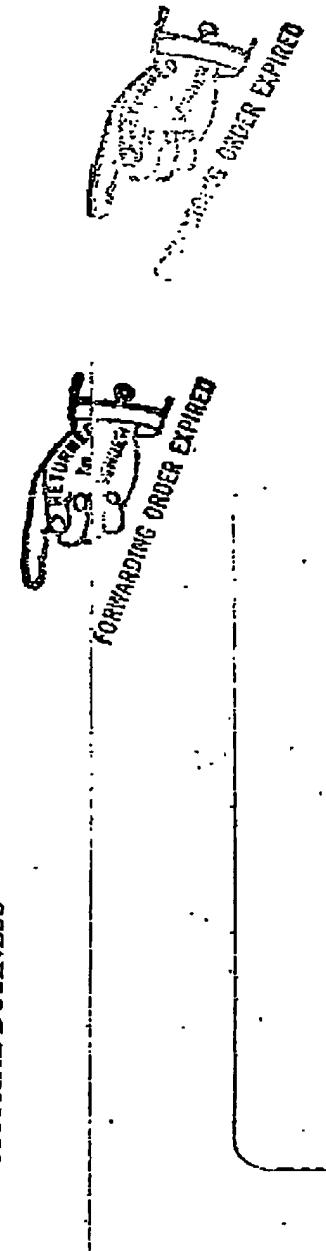


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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/463,145	FORD, PETER
	Examiner Benjamin E Lanier	Art Unit 2132

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 11 February 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 19-25 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19-25 and 27-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Disposition of Claims**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 January 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-946)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-162)  
 6) Other: \_\_\_\_\_

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## **DETAILED ACTION**

### *Response to Amendment*

1. Applicant's amendment filed 11 February 2005 amends claims 19, 21, 22, 24, 28, 29, 32, 37 and cancels claim 26. Applicant's amendment has been fully considered and is entered.

### *Response to Arguments*

2. Applicant's arguments filed 11 February 2005 have been fully considered but they are not persuasive.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. Applicant's arguments that the prior art does not disclose transmitting a transfer protocol identifier indicating that the encrypted broadcast message is of a type for data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module in response to receipt of said transfer protocol identifier is not persuasive because Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). The SMS

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messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24), which meets the limitation of data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20), and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 19, 20, 24-36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290. Referring to claims 19, 20, 24, 25, 27-30, 32-34, 36, and 37, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20); and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

Referring to claim 26, Diachina discloses that the SMS messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33).

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Referring to claims 31 and 35, Diachina discloses that the channel can be GSM (Page 6, line 20).

8. Claims 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290 as applied to claim 19 above, and further in view of Farrugia. Referring to claims 21-23, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). Diachina does not disclose storing the keys on the smart cards in an encrypted form. Farrugia discloses the use of smart card technology with cellular networks where the key used to decrypt encrypted cellular message are stored in an encrypted fashion on the smart card of the subscribers mobile terminal (Page 101). It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the keys of Diachina on the smart cards in order to control access to the keys as taught in Farrugia (Page 102).

*Conclusion*

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barton can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*BL*  
Benjamin E. Lanier

*Gilberto B.*  
GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

12/15/05 12:44 FAX 16192350176

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,146	04/14/2000	PETER FORD	RJENK9.001AP	5908
20995	7590	11/01/2005		EXAMINER
KNOBBE MARTENS OLSON & BEAR LLP			LANIER, BENJAMIN B	
2040 MAIN STREET				
FOURTEENTH FLOOR				
IRVINE, CA 92614			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Notice of Abandonment</b>	Application No.	Applicant(s)
	09/463,146	FORD, PETER
	Examiner	Art Unit
	Benjamin E. Lanier	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 17 March 2005.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7.  The reason(s) below:

*Gilberto Barron Jr.*  
GILBERTO BARRON JR.  
SUPPLYING PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

U.S. Patent and Trademark Office  
PTOL-1492 (Rev. 04-01)

Notice of Abandonment

Part of Paper No. 20051028

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